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PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/632,139
Filing Date: August 03, 2000
Appellant(s): IMANAKA, RYOICHI

Lawrence E. Ashery
For Appellant

EXAMINER'S ANSWER

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This is in response to the corrected brief, filed 11/11/09, and the appeal brief filed 09/30/2009 appealing from the Office action mailed 5/20/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

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(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

| | | |
|------------------|-------------------|----------------|
| 4,945,563 | HORTON | 7-1990 |
| 4,949,187 | COHEN | 8-1990 |
| 5,671,202 | BROWNSTEIN | 9-1997 |
| 4,882,752 | LINDMAN | 11-1989 |
| 5,552,776 | WADE | 9-1996 |
| 5,903,407 | TSAI | 5-1999 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14, 17-19, 21-22 & 37, 40, 42, 45, 47, 49, 51, 53, 55 & 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, (U.S. Pat # 4,945,563) in view of Brownstein, (U.S. Pat # 5,671,202) and Cohen, (U.S. Pat # 4,949,187).

Considering amended claim 14, the claimed *computer information system comprising a provider for providing information to a recipient* reads on the central office connected to the cable TV or satellite distribution system; see Horton col. 3, lines 61-68.

Regarding the further claimed limitation of a *'provider receiving signaling from a recipient for the provider to provide the information to the recipient'*, even though the background of Horton mentions PPV, col. 1, lines 10-40, the invention itself does not discuss any subscriber requests to a headend for transmission of a movie. Nevertheless Cohen, which is in the same field of transmission of a movie to a subscriber terminal, includes a further teaching of the subscriber entering a movie selection via a keypad 102, which is transmitted upstream to a central source 4, see col. 3, lines 61-67; col. 4, lines 47-64; Fig. 4. In particular, Cohen teaches that the customer orders a particular movie, which is then transmitted to the customer at the appropriate time, see col. 5, lines 1-10. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Horton in a subscriber request system for the desirable benefit of allowing the subscriber to watch whatever movie desired at whatever time desired without needing to drive to movie rental store, as taught by Cohen, see col. 1, lines 12-44; col. 2, lines 3-18; col. 3, lines 9-31.

The additional claimed feature of the *'provider charging a different amount to the recipient depending upon whether the information is recorded or permitted to be recorded'* reads on the disclosure of Horton that a subscriber may preview a movie free-of-charge (or for a reduced fee), may be charged a certain 1st amount for viewing the movie and a 2nd different amount is charged when the movie is ordered for recording, col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34.

Horton does not teach the amended claimed features, *'to be recorded in a non-sequentially accessible medium' ... 'is permitted if a value of an identifier read from the medium is a registered ID value...recording of the information in the medium is prevented if any registered ID value is not readable from the medium'*. Nevertheless, Brownstein provides a disclosure of a security system that operates by storing a medium signal identification group and/or embedded characters, (which reads on the claimed *'identifier read from said recording medium'*), at least in order to prevent inappropriate material from being stored on the instant recording medium, see Abstract; Fig. 5-6; Fig. 8 & 9A-9B; col. 7, lines 31-50; col. 9, lines 35-61 & col. 10, lines 1-26. In particular, Brownstein teaches that in order to store a file, the instant file must contain an identifier that matches an identifier stored on the recording medium to which the file would be stored, see col. 9, lines 36-67; col. 10, lines 41-67 thru col. 11, lines 1-5. Since Brownstein (col. 1, lines 25-50; col. 4, lines 21-31; col. 11, lines 42-58) discloses that the

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recording medium may include an optical storage disk, as well as a compact disk, CD, the amended claimed feature of the, '*non-sequentially accessible medium*', is met by the reference.

It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the technique of only recording information on a particular recording medium after verifying that a registered recording medium being identified, at least for purpose of ensuring that only certain files, such as only specific image files are stored on a particular recording medium, as taught by Brownstein, col. 3, lines 20-45 & col. 11, lines 1-17, which teaches that an owner of specific images can control to which recording medium the instant images are stored.

As for the claimed computer information system, Brownstein does not discuss which type of system that the optical storage disks and/or compact disks/CD are used. However, Official Notice is taken that the use of optical disks and/or compact disks/CD in a PC system was old in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Horton & Brownstein with the technology of operating the optical storage disk in a PC system, at least for the desirable advantage of enabling a wide range of interactivity with the instant optical storage disk, inherent in its use in a PC system.

Considering claim 17, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected.

Considering claim 18, the claimed elements of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected. As for the different feature of receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

Considering claim 19, the claimed elements of a computer information system that corresponds with subject matter mentioned above in the rejection of claim 14, are likewise rejected. As for the different feature of a recipient for receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

Considering claim 21, the claimed signal transmitted from a recipient of information to a provider of information, such that the signal indicates whether the information is recorded in a medium, is met by the disclosure in Horton that the decoder 28 could provide billing information to the store and hold circuit 46, which is then transmitted to the proper billing authority, see col. 3, lines 35-60. The instant billing information shows which viewing mode was selected by the subscriber, and thus what charges are being billed.

Considering claim 22, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 21, and are likewise rejected.

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Considering claim 37, the claimed elements of an information receiver, correspond substantially with the subject matter mentioned above in the rejection of claims 14 & 19, and are likewise rejected.

Considering claim 40, the claimed 'informing designating unit designate the information', is broad enough to the read on the decoder 28, that decodes the coded information and provides an indication to the user of the various modes of the particular decoded program, see Horton, col. 3, lines 35-42.

Considering claim 42, the information processed and viewed in Horton and is audio/video information.

Considering claims 45, 47, 49, 51, 53, 55, & 57, '*wherein the registered ID value is provided by the provider*', in Horton the taping mode may be selected by the operator 32, but the authorization code is embedded in the TV signal, col. 3, lines 32-67; col. 4, lines 1-45. Horton also teaches that alternatively, the pre-authorization code may be transmitted to the receiver, which also indicates the reception/taping mode. Furthermore, in Brownstein, the file identification signal group data is embedded with the instant file, which reads on, '*registered ID value is provided by the provider*', col. 9, lines 35-45; col. 10, lines 66-67 & col. 11, lines 24-26.

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3. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, Brownstein & Cohen as applied to claim 37 above, and further in view of Lindman, (U.S. Pat # 4,882,752).

Considering claim 41, even though both Horton & Brownstein discuss the use of identifiers, the references do not discuss the additionally claimed feature of, '*an informing unit to inform that the identifier is wrong, if the identifier is not registered*'. Brownstein merely discloses that if the file to be stored on the recording medium does not contain the identifier that matches the identifier on the instant recording medium, then the storage procedure is stopped, see Fig. 9B. Nevertheless, Lindman (col. 9, lines 10-47; col. 10, lines 62-68 thru col. 11, lines 1-15 & Fig. 5) provides a teaching of informing a user of terminal 12a or 12b, with security message when the personal ID code entered is not registered for authorization to use the system. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Horton & Brownstein with the feature of informing a user when their personal ID is not authorized to access the system, at least for the desirable purpose of warning the operator that further communication/action is not authorized, as taught by Lindman, col. 9, lines 40-47.

4. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, Cohen & Brownstein and further in view of Wade, (U.S. Pat # 5,552,776).

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Considering claim 58, Brownstein teaches permitting a file to BE stored on a recording medium, based on the identifier read from the recording medium, but does not explicitly disclose the feature with respect to the *'drive ID'*. Nevertheless Wade, which is in the same field of endeavor meets the claimed subject matter, since it teaches controlling the access to various devices within a computer (such as removable or fixed disk drives), based on the level of access associated with an individual user or a group, see col. 7, lines 8-50; col. 8, lines 54-67 thru col. 9, lines 1-30. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Horton & Brownstein, with the feature of controlling access to devices within a computer for the advantage of providing a security algorithm that insures that unauthorized users are not able to modify the contents or configurations of the various components of a computer, as taught by Wade, see col. 1, lines 10-67 thru col. 2, lines 1-67.

5. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, Cohen & Brownstein, and further in view of Tsai, (U.S. Pat # 5,903,407).

Considering claim 59, Horton and Brownstein do not discuss any feature regarding automated *'deletion of programs from the recording medium'*. Nevertheless Tsai, which is in the same field of endeavor, teaches that a user may set an "auto-overwrite", so that for instance movies older than a certain data will be overwritten. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Horton

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& Brownstein, with the feature of automatically removing programs older than a certain date, as taught by Tsai, at least for the desirable benefit of allowing incoming programs to be recorded, especially when there presently is not enough storage space, by removing (overwriting) programs that the user would more likely not want to maintain, based on their age in the storage medium.

It is noted that Tsai specifically discusses the automated removal of old programs feature with respect to the overwrite technique, but does not explicitly discuss the automated removal of old programs feature with respect to the erasing technique. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate the combination of Horton & Tsai, in a manner such that the old programs would be optionally erased, at least for the purpose of being able to demonstrate storage space that has been created, which can be used to record new programs.

Allowable Subject Matter

6. Claims 60-68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(10) Response to Argument

Appellant's claims are directed to a method for a provider to provide information, e.g., a movie, to a customer, such that the customer is charged a 1st fee to view the information only. The customer is charged a 2nd fee, (different from the 1st fee), to view & record the instant information. The Appeal Brief on pages 6-7 provides a synopsis of Horton and a chart on page 7 of the four viewing modes of operation in Horton.

However, appellant's only argument appears to be (starting on page 6 of the Appeal Brief) that since none of the four viewing modes of operation in Horton teaches the entirety of the relevant subject matter, by itself, that the reference does not meet the claimed subject matter. Examiner respectfully disagrees. Horton indeed teaches four viewing modes of operation, which appellant has outlined on a chart on pages 6-7 of the brief.

It is pointed out **that it is the combination of at least two of the viewing modes** that meet the claimed subject matter, not simply one or the other viewing mode. In particular, the operator is charged a certain fee to view only a movie, (i.e., view mode) which reads on the claimed, viewing without recording. The operator is then charged a different fee for recording the movie, in the view & record mode, as outlined in the Appeal Brief. Even though appellant argues on page 7 and shows in the chart on the same page 7 that there is no fee in the view mode,

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examiner disagrees and points out that Horton explicitly states that there is a fee charged in the view mode, see col. 2, lines 59-62. Horton teaches, “Any subscriber would have the option of choosing to merely view the programming for which he **would pay a first fee**, or he could chose to view the programming as well as create a first copy of the program upon the payment of a **second higher fee**..., emphasis added”.

Furthermore, even if it were assumed that the view mode is free; such an embodiment in Horton would still meet the claim. This is true since the charge for viewing, without recording would be a charge of \$0. Whereas, there is a specific monetary fee for viewing & recording (col. 3, lines 49-51), as admitted by appellant.

Finally, Horton also teaches a sneak preview mode, (col. 4, lines 20-34) wherein the operator can view the program on a sneak basis, without recording, but with a reduced charge, since the operator answers some questions. Therefore, this mode also clearly reads on the claimed viewing without recording, for a 1st fee. As an addendum, examiner points out that the fact that Horton discloses that the sneak preview may be viewed at a reduced cost, is a clear suggestion that the regular view mode, without recording, as discussed earlier, would normally have a fee.

Appellant presents an additional argument on pages 7-8, namely that even though the other reference, Cohen, teaches VOD, its combination with Horton would still not meet the claimed subject matter. To this argument, examiner respectfully points out that the Cohen

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reference is not relied upon, nor is it necessary for this subject matter in the rejection. As demonstrated above, Horton clearly teaches a view mode, without recording, wherein a 1st fee is charged to the subscriber. Horton also teaches a viewing & recording mode, wherein a 2nd fee is charged, different from the 1st fee, see col. 2, lines 56-65, which answers all arguments set forth by the appellant, and meets the relevant claimed subject matter.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Reuben M. Brown/

Patent Examiner, Art Unit 2424

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